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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,446	11/08/2001	Wolfgang Schneider	VAW-5	5083

21890 7590 11/04/2004

PROSKAUER ROSE LLP
PATENT DEPARTMENT
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EXAMINER

MENON, KRISHNAN S

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/986,446

Applicant(s)

SCHNEIDER ET AL.

Examiner

Krishnan S Menon

Art Unit

1723

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 12, 14-18 and 21-24.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: attachment with response to arguments

Response to Amendment

The amendments will be entered because it reduces the issues for appeal.

Amended claims would be rejected as follows:

1. Claims 12, 21, 24 and 22(12,13,19-21) {Claims 22 as it depends from claims 12, 13, and 19-21} and 23 (12,13,19-21) are rejected under 35 U.S.C. 103(a) as being unpatentable over JP(357) in view of Gesing et al (US 4,790,873).
2. Claims 14-17, 22 (14-17) and 23 (14-17) are rejected under 35 U.S.C. 103(a) as being unpatentable over JP (357) in view of Gesing et al (US 4,790,870) as in claim 12 above and further in view of Dore (US 4,113,241).
3. Claims 18, 22 (18) and 23 (18) are rejected under 35 U.S.C. 103(a) as being unpatentable over JP(357) in view of Gesing et al (US 4,790,870) as in claim 12 above and further in view of Walker (US 4,834,876).

Response to Arguments

Applicant's arguments filed 10/6/04 have been fully considered but they are not persuasive.

In response to the argument that one of ordinary skill would not modify JP'357 in view of US'873 because of the totally different arrangement of the filter in US'873, the test for obviousness is not whether the features of a secondary reference may be bodily

incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to the argument that 'impurities resulting from adding grain refining additives should not reach the first filter, and the "all other inclusions" should not reach the second filter but should be already removed by the first filter' are taught by or inherent in the JP ref, and therefore the argument that '873 reference teaches differently is irrelevant. Also, some embodiments of '873 do teach (or inherent) this feature (fig 7 and 8, for example).

Argument that '873 adds salt-melt for filtration: this argument is also not relevant because the claims are open-ended, and do not preclude additional elements of the reference.

Argument that '873 teaches that "the deep-bed filter can only remove metal-wettable inclusions in an effective way when at the same time salt droplets accumulate on the surface of the filter, which salt droplets have to be created by a first filter arranged before the deep-bed filter": there is no such teaching in '873, and this argument is purely conjecture on the applicants' part.

In response to the argument, "Finally, US '873 teaches that the second filter usually clogs very fast. That's why according to US '873 only cheap plate-filters are used as second filters": again, this is not something US'873 teaches. US'873 teaches bed filters.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Krishnan Menon
Patent Examiner


W. L. WALKER
SUPERVISORY PATENT EXAMINER
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